

1632  
PATENT

Docket No. 17259(AP)  
Dolly et al.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**Applicant:** Dolly et al. )  
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**Serial No.:** 09/294,980 )  
)  
**Filed:** April 19, 1999 )  
)  
**For:** Compositions and Methods for )  
Modulating Neural Sprouting )  
\_\_\_\_\_ )

**Group Art Unit:** 1632

**Examiner:** A. Baker

REPLY TO RESTRICTION REQUIREMENT

Box Non-Fee Amendment  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to the Restriction Requirement dated December 18, 2000, and the subsequent communication of March 28, 2001, we provisionally elect Examiner's Group III, drawn to methods for extending the effective time tissue is paralyzed with a clostridial toxin comprising the use of an agent that prevents the expression of various neurotrophic genes, to be prosecuted in the subject patent application.

With regard to the election of species requirement, Applicants provisionally elect to prosecute claims directed to a composition within the Group elected above which is able to prevent the neuroregenerative activity of ciliary neurotrophic factor (CNTF), with traverse.

The Examiner states that the application claims are directed to "the following patentably

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope having sufficient postage addressed to: Box Non-Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231 on:

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Person making Deposit: Bonnie Ferguson

Signature: Bonnie Ferguson

Date of Signature: 4/17/01

distinct species of the claimed invention", then lists the member of the Markush group of claim 1. The Examiner justifies the election of species requirement because these proteins "are different proteins requiring different searches". However none of the claims are drawn to these proteins. Rather, the pending claims are drawn to agents which prevent the activity of these proteins. Such agents may include ribozymes, antisense agents and the like.

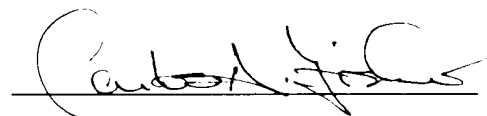
Without expressing an opinion as to whether claims directed to the proteins included in the Markush group are independent and distinct, Applicants would argue an election of species based on methods for the inhibition clostridial neurotoxin paralysis is improper. As a non-limiting example, antisense agents directed to the mRNA promoter and regions encoding the N terminal residues of these proteins, while not necessarily identical, would have a common utility and share substantial structural features (i.e., polynucleotides (or analogs thereof) containing nucleotide sequences complementary to the ATG start codon). MPEP § 803.02 indicates that there is unity of invention when such features exist in a claimed member of a Markush group; a method of using such agents for a single purpose also possesses unity of invention.

For these reasons the Examiner is respectfully urged to reconsider and withdraw the outstanding election of species requirement.

No fee is thought dues in connection with this communication. However, if Applicant is incorrect in this regard, kindly use our Deposit Account 01-0885 for the payment of any fee now due.

Dated: 4/16/01

Respectfully submitted,



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